REMARKS

Claims 1, 4-6, 8, 30, 31, 36-38 and 40 were examined in the Final Office Action dated 02/08/2010 (hereafter "Outstanding Final Office Action"). Claims 11, 14-16, 18-20,

5   32, and 33 stand withdrawn.

All the examined claims were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent No. 7,089,286 issued to Malik (hereafter "Malik") in view of US Publication No. 2005/0055464 naming as inventor Weller (hereafter "Weller"). Claim 8

10   was rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik in view of Weller as applied to claims 1,4-6, and 30-31 above, and in view US Publication No. 2005/0144309 naming as inventor Gish (hereafter "Gish"). Claims 36-40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Malik in view of Weller.

15   Without acquiescing to any of the Examiner's assertions, withdrawal of the final rejection is respectfully requested, based further on the below remarks.

As stated in MPEP § 2143.01, the claimed combination **cannot change the principle of operation of the primary reference** or render the reference inoperable for its intended

20   purpose. The combination proposed by the Examiner violates this requirements, as explained below.

The Examiner relies on Malik as the primary reference for most of the features of claim 1, and then relies on Weller for the feature of "determines not to send said data in said

25   compressed format if the processing load on said server system is determined to be more than a first threshold."

The combination proposed by the Examiner changes the principle of operation of Malik in that the embodiments of Malik seek to **compress mail attachments when network**

30   **traffic is high (and not compress when the traffic is low)**.

In sharp contrast, the modification according to claim 1, would require **no compression when the processing load is high,** given that the Examiner equates the network traffic of Malik to the claimed processing load.

Thus, the principle of operation of Malik would be changed by the modification proposed by the Examiner, and accordingly is impermissible under the applicable law/ practice. The rejection under 35 U.S.C. § 103 is accordingly prima facie defective.

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Independent claims 36 and 40 are also allowable over the art of record for similar reasons.

The dependent claims are allowable at least for reasons noted above with respect to
10   the corresponding base/independent claims.

Conclusion

All the rejections and objections are thus believed to have been overcome and continuation of examination is respectfully requested. The Examiner is invited to telephone
15   the undersigned representative at 443-552-7281 (4AM-noon EST) if it is believed that an interview might be useful for any reason.

Respectfully submitted,

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